



DAE#
#13

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

OLIVER et al.

Application No. 09/361,678

Filed: July 27, 1999

For: METHOD AND SYSTEM FOR
INTERNET PERSONALIZATION

Group Art Unit: 2177

Examiner: Srirama T. Channavajjala

Attorney Docket No. MAILP019

RECEIVED

JUL 15 2004

OFFICE OF PETITIONS

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as First Class Mail in an envelope addressed to: Mail Stop Petition, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on July 7, 2004.

Signed: _____

Jennifer C. Gross

**PETITION FOR REVIVAL OF AN APPLICATION FOR PATENT
ABANDONED UNINTENTIONALLY UNDER 37 CFR 1.137(b)**

Attention: Office of Petitions
Mail Stop Petition
Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450

Sir:

The above-identified application became abandoned for failure to file a timely and proper reply to a notice or action by the United States Patent and Trademark Office. The date of abandonment is the day after the expiration date of the period set for reply in the Office notice or action plus an extensions of time actually obtained.

APPLICANT HEREBY PETITIONS FOR REVIVAL OF THIS APPLICATION

1. Petition Fee

☐ Small Entity

☒ Large Entity

☒ Enclosed is Check No. 1343 in the amount of \$1,330.00.

☒ Charge any additional fees or credit any overpayment to Deposit Account No. 50-0685
(Order No. MAILP019).

Attorney Docket No. MAILP019

07/14/2004 AHONDAF1 00000122 09361678 1330.00 OP
01 FC:1453

2. Reply and/or fee

A. The reply and/or fee to the above-noted Office action in the form of a Response to Restriction Requirement.

☐ has been filed.

☒ is enclosed herewith.

B. The issue fee of \$_____.

☐ has been paid previously on _____.

☐ is enclosed herewith.

3. Terminal disclaimer with disclaimer fee

☒ Since this utility/plant application was filed on or after June 8, 1995, no terminal disclaimer is required.

☐ A terminal disclaimer (and disclaimer fee (37 CFR 1.20 (d)) of \$_____) disclaiming the required period of time is enclosed herewith.

4. STATEMENT: The entire delay in filing the required reply from the due date for the required reply until the filing of a grantable petition under 37 CFR 1.137(b) was unintentional.

Enclosures: ☒ Fee Payment


☒ Reply

☐ Terminal Disclaimer Form

☒ Additional sheets containing statements establishing unintentional delay.

☒ Other: Statement Under 37 CFR 3.73 (b), and copies of four assignments.

Respectfully submitted,



Lee Van Pelt

Reg. No. 38,352

VAN PELT & YI LLP
10050 N. Foothill Blvd.
Suite 200
Cupertino, CA 95014
(408) 973-2585

Statement Describing Circumstances of Unintentional Abandonment and Subsequent Delay

On 5-16-02, United States Patent Application No. 09/361,678 (the 678 Patent Application) was assigned from Dynaptics Corporation (Dynaptics), which was in bankruptcy proceedings, to Skychange, Inc (Skychange). The assignment from Dynaptics to Skychange was not recorded and no change of address was filed with the PTO.

The restriction requirement mailed 11-18-02 did not reach Skychange. On 4-29-03, Fernandez and Associates, attorney for Dynaptics, filed a petition to withdraw, stating that Dynaptics had filed for bankruptcy and was no longer his client. He changed the correspondence address to the address of Kevin Coleman, an attorney involved with the Dynaptics bankruptcy proceedings.

On 7-7-03, Examiner Channavajjala called Mr. Coleman. The Notice of Abandonment mailed on 7-8-03 to Mr. Coleman indicates that Examiner Channavajjala understood from Mr. Coleman that the case was being transferred to Fernandez and Associates and that Examiner Channavajjala had contacted Fernandez and Associates and been informed that they were not dealing with the case and that further information was not available.

Mr. Coleman contacted Melissa Neumann, CEO of Skychange, and explained to her that the 678 Patent Application was in danger of becoming abandoned and wrote a letter to the PTO on 7-11-03 (Attachment 1) explaining that Fernandez and Associates was not involved in the case and that the 678 Patent Application had been assigned to Skychange and that Skychange remained interested in maintaining the application.

On 7-17-03, Ms. Neumann wrote a letter (Attachment 2) to Examiner Channavajjala explaining that Skychange had been informed that the patent "risks being abandoned" and "would like to keep this patent alive."

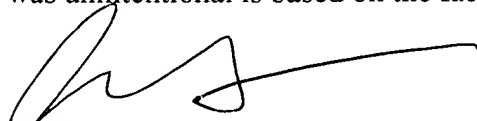
The PTO informed Ms. Neumann a response needed to be filed and Ms. Neumann has since that time been attempting to get access to the 678 Patent Application file in order to determine the response that is required. She understood from the PTO that she needed to establish ownership to access the file and she was directed to Darlene Lyon of the PTO. On 8-21-03, Ms. Neumann wrote a letter (Attachment 3) to Ms. Lyon enclosing the assignment to Skychange and asking whether the paperwork submitted was sufficient proof of ownership to "transfer power of attorney to Skychange." At some point, Ms. Neumann came to believe that it was necessary to record the assignment to Skychange in order to access the file.

After following up with Ms. Lyon, Ms. Neumann was directed to Francis Hicks of the PTO. Ms. Hicks helped Ms. Neumann prepare a cover sheet to submit the assignment to Skychange to be recorded. On 1-29-04, Ms. Neumann submitted the assignment with the cover sheet and also sent a letter to the Assignment Branch asking whether any additional information was needed to transfer power of attorney in the case to Skychange. Since 1-

29-04, Ms. Neumann has been periodically contacting the PTO to see if the assignment has been recorded. The Assignment Branch has explained to her that the assignment will not likely be recorded before August of 2004.

Ms. Hicks has explained to Ms. Neumann that it is very important to submit a petition to revive the 678 Patent Application before the one year anniversary of the mailing of the Notice of Abandonment. Ms. Neumann has not filed such a petition because of the need to file a response which she has not done as a result of not yet obtaining access to the file.

On 7-1-04, Skychange assigned the 678 Patent Application to Mailfrontier, Inc. (Mailfrontier). I represent Mailfrontier. I have obtained the 678 Patent Application prosecution history and am submitting the response that was due along with a petition to revive the case. My statement that the abandonment and subsequent delay by Skychange was unintentional is based on the facts above.

A handwritten signature in black ink, appearing to read 'Lee Van Pelt', with a long horizontal stroke extending to the right.

Lee Van Pelt
Reg. No. 38,352

Attachments



ATTACHMENT 1



McNutt & Litteneker, LLP
188 The Embarcadero, Suite 800
San Francisco, California 94105
Tel. (415) 995-8475
Fax (415) 995-8487

2177
#11
7/23/03
A.W.

Email: kcoleman@ml-sf.com

July 11, 2003

VIA FACSIMILE AND FIRST CLASS MAIL

Commissioner for Patents
United States Patent & Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

RECEIVED
JUL 17 2003
Technology Center 2100

Re: **Dynaptics Corporation**
Case No. 01-55690 MM, Chapter 7

US Patent Application #09/361,678
Filed: July 27, 1999
Title: Method and System for Internet Personalization
Inventor: Oliver, et al.

Dear Sir/Madam:

This office is in receipt of your Notice of Abandonment concerning Patent Application No. 09/361,6678. I write because the reasons given by the Primary Examiner, Mr. Srirama Channavajjala, for giving notice of the abandonment are erroneous.

When Mr. Channavajjala called me on Monday, July 7, 2003, we discussed the following circumstances at length:

- Dynaptics Corp. ("Debtor"), the entity seeking the patent, filed a voluntary petition under Chapter 7 of the United States Bankruptcy Code on November 9, 2001.
- I represent Suzanne L. Decker, the Chapter 7 trustee appointed in the Debtor's bankruptcy case.
- Fernandez & Associates, the attorneys who represented Dynaptics Corp. in connection with the patent application, did not at any time represent the Trustee or the bankruptcy estate in connection with the pending application.

Commissioner for Patents

July 11, 2003

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- During the course of the bankruptcy case, the Trustee sold all rights to the pending patent to an entity known as Skychange, Inc.
- The Patent and Trademark Office's communication which required a response was apparently directed to Fernandez & Associates.
- To the best of my knowledge (based upon the fact that Fernandez & Assoc. had no professional duties to either the Trustee or Skychange), Fernandez & Associates did not notify Skychange of any communication from the PTO which required a response.
- I would endeavor to contact Skychange immediately (which I did, see enclosed letter) advising it that it must act immediately to notify the PTO of the assignment of the rights to the pending patent application, and ascertain what the PTO required in order to avoid abandonment of the pending application.

In the course of this conversation, Mr. Channavajjala advised me that Skychange should send written confirmation to the PTO of the assignment and that it would be given a reasonable opportunity to remedy any defects which put it at risk of having the patent application abandoned.

Somehow, Mr. Channavajjala took from our conversation that Fernandez & Associates remained involved in the pending application, which is not true. I did not advise Mr. Channavajjala that the pending application was "being transferred to Fernandez & Associates." To the contrary, I told him that it had been transferred to Skychange, and that Fernandez did not represent Skychange. Apparently, when he later contacted Fernandez & Associates, it stated that it no longer represented the holder of the pending application (which is true, as we had discussed). I fear that when Fernandez & Associates stated to Mr. Channavajjala that it was "not dealing with the application," he interpreted that statement to mean that the actual holder had decided not to continue prosecuting the application. Yet as far as I know, Skychange remains interested in maintaining the application.


While the trustee of Dynaptics Corp. no longer holds an interest in the pending application, I feel compelled to write to advise the PTO that from my perspective, its decision to deem the pending application abandoned may have been based upon erroneous facts.

I respectfully submit that it may be appropriate for the PTO to consider the foregoing circumstances on its decision to deem the application abandoned, and give Skychange an opportunity to cure any defects in the pending application. Skychange's current address is set forth below.

Commissioner for Patents
July 11, 2003
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Thank you for your time and consideration in this matter.

Very truly yours,



Kevin W. Coleman

KWC/jat

cc: Srirama Channavajjala
Jonathan Oliver
Sara Krueger, President
Skychange, Inc. (via fax)
145 W. 58th Street, Suite 14M
New York, NY 10019



ATTACHMENT 2

Sent By: Skychange, Inc;



212 956 0792;

Jul-17-03 28;

Page 1/1



424 West End Avenue • New York, NY 10024 • tel/ 212-787-43717 • fax/ 413-843-8812
www.skychange.com



RE: US Patent Application #09/361,678 Filed July 27, 1999, Method and System for Internet Personalization Purchased from Dynaptics Corporation

Attention: Mr. Sri Rama
Fax: 703-305-9731

July 17, 2003

Dear Mr. Sri Rama:

This letter acknowledges Skychange, Inc.'s purchase of the above referenced patent application from Dynaptics Corporation. Skychange, Inc. has been informed that the patent risks being abandoned. This letter confirms that Skychange, Inc. would like to keep this patent alive.

Please advise whether all necessary payments have been made to date, and when the next payment is due. Please also advise what the PTO requires so that we can make arrangements to provide the PTO with what it needs to avoid abandonment of the pending application.

Please do not hesitate to contact me directly or fax me at the number on the letterhead above.

Sincerely,

Melissa Neumann

ATTACHMENT 3

Sent By: MELISSA NEUMANN

2127874717;

Jul-1-04 6:48PM;

Page 1/8

Sent By: MELISSA NEUMANN

2127874717;

Aug-21-03 9:23AM;

Page 2



SKYCHANGE™

424 West End Avenue • New York, NY 10024 • tel/ 212-787-63717 • fax/ 831-855-5531
www.skychange.com

RE: US Patent Application #09/723,855 and #09/361,678 Purchased from Dynaptics Corporation

Attention: Ms. Darlene Lyon

Fax: 703-308-5053

Assignment Branch

August 21, 2003

Dear Ms. Darlene Lyon:

This letter acknowledges Skychange, Inc.'s purchase of the above referenced patent applications from Dynaptics Corporation. Please advise whether the paperwork enclosed is sufficient proof of ownership to transfer power of attorney for the above referenced patents to Skychange, Inc.

Walt Froloff from Patent Alchemy will represent Skychange, Inc. for the above patent as the Company's patent agent. His address is: 273D Searidge Road, Aptos, CA 95003. His phone number is: 831-685-2446.

Please do not hesitate to contact me directly or fax me at the number on the letterhead above if you have any questions.

Sincerely,

Melissa Neumann

ATTACHMENT 4

January 29, 2004

Melissa Neumann
 Skychange, Inc.
 424 West End Ave, #5F
 New York, NY 10024
 Tel: 212-787-4717
 Mobile: 917-620-2422
 West Coast: 650-522-8541

Re. US Patent Application #09/723,855 and #09/361,678 Skychange, Inc. Purchased from Dynaptics Corporation

Dear Assignment Branch:

This letter acknowledges Skychange, Inc.'s purchase of the above referenced patent applications from Dynaptics Corporation. Please advise whether you need any additional information prior to transferring power of attorney fro the referenced patents above to Skychange, Inc.

Walt Forloff from Patent Alchemy will represent Skychange ,Inc. for the above patent as the Company's patent agent. His address is: 273D Searidge Road, Aptos, CA 95003. His phone number is: 831-685-2446.

Please do not hesitate to contact me directly if you have any questions. My phone number is: 212-787-4717.

Sincerely,



Melissa Neumann
 Founder & Co-CEO
 Skychange, Inc.